UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,647	09/12/2003	Peter H. Markusch	PO7930/MD-01-104	9354

157 7590 01/23/2006

BAYER MATERIAL SCIENCE LLC
100 BAYER ROAD
PITTSBURGH, PA 15205

EXAMINER	
MATZEK, MATTHEW D	
ART UNIT	**PAPER NUMBER**
1771	

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/661,647	MARKUSCH ET AL.	
	Examiner	Art Unit	
	Matthew D. Matzek	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/10/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

1. Applicant's election without traverse of Claims 1-11 in the reply filed on 10/20/2005 is acknowledged. Non-elected claims 12-21 have been canceled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The terms "thicker" and "more sponge-like" in claim 8 are relative terms, which render the claim indefinite. The terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Neither the claims nor the specification give guidance to determine what the geotextiles are thicker than or more sponge-like than. Also, the term "sponge-like" itself renders the claims indefinite since it is unclear to what sponge properties the term refers or if the limitation permits/precludes sponges.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 8-9 rejected under 35 U.S.C. 102(b) as being anticipated by Chaverot et al. (US 5,445,473).

Chaverot et al. teach a nonwoven geotextile impregnated with an aqueous emulsion of asphalt/polymeric binder (col. 5, lines 50-57). Claim 24 teaches that the binder may impregnate the geotextile at a level of 1.5 kg/m^2. Claim 2 is rejected as the applied article may be used as ditch liner. The applied patent does not teach the instantly claimed solid content of the aqueous dispersion. However, the final product of the instant application does not contain an aqueous dispersion instead it is a geotextile with polymeric binder. Therefore the applied art anticipates the final product of the instant application.

5. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Dahmen et al. (US 4,771,131).

Dahmen et al. teach a process for the production of textiles coated with an aqueous coating of polyurethane (Abstract, Example 3). The solids content of the coating is generally between 10 and 60 weight percent (col. 2, lines 35-37). The applied invention is directed to industrial textiles that are water-resistant, therefore it may serve as a ditch liner (Abstract).

6. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Markusch al. (US 4,771,131).

Markusch et al. teach an aqueous dispersion of polyurethane-urea used to be used as a coating or film (Abstract). The final product has a solids content of up to about 60% by weight (col. 15, lines 14-18). The applied dispersion may be applied to a variety of substrates (col. 16, lines 18-21). Table III teaches the instantly claimed tensile strength, elongation and water pickup of claims 5 and 6 and Example XIII of Table V teaches the water pickup of instant claim 7. Examiner interprets the term "about" to include values that are 10% greater or less than the claimed value (i.e. claim 6=10% +/- 1%; claim 7=5%+/-0.5%).

7. Claims 1-5 and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Markusch et al. (US 2003/020675).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Markusch et al. teach a polyurethane treated geotextile for use as a ditch liner (Abstract). The applied geotextile anticipates the instantly claimed thickness and polyurethane basis weights [0071 and 0072]. Examples provided in Table 2 anticipate the instantly claimed elongation and tensile strength. The applied patent does not teach the instantly claimed solid content of an aqueous dispersion. However, the final product of the instant application does not contain an aqueous dispersion instead it is a geotextile with

polymeric binder. Therefore the applied art anticipates the final product of the instant application.

8. Claims 1-4 and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Markusch et al. (US 2003/0032718).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Markusch et al. teach a polyurethane treated geotextile for use as a ditch liner (Abstract). The applied geotextile anticipates the instantly claimed thickness and polyurethane basis weights [0067 and 0068]. The applied patent does not teach the instantly claimed solid content of an aqueous dispersion. However, the final product of the instant application does not contain an aqueous dispersion instead it is a geotextile with polymeric binder. Therefore the applied art anticipates the final product of the instant application.

9. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Markusch et al. (US 2002/0172565).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Markusch et al. teach a water-resistant polyurethane treated geotextile for use as a ditch liner (Abstract). The applied geotextile anticipates the instantly claimed thickness and polyurethane basis weights [0064 and 0065]. Table 2 teaches the instantly claimed water absorption and Table 3 teaches the instantly claimed tensile strength and elongation. The applied patent does not teach the instantly claimed solid content of an aqueous dispersion. However, the final product of the instant application does not contain an aqueous dispersion instead it is a geotextile with polymeric binder. Therefore the applied art anticipates the final product of the instant application.

10. Claims 1-5 and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Markusch et al. (US 2002/0168907).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Markusch et al. teach a polyurethane treated geotextile for use as a ditch liner (Abstract). The applied geotextile anticipates the instantly claimed thickness and polyurethane basis weights [0055 and 0056]. The Table on page 5 teaches the instantly claimed the instantly claimed tensile strength and elongation. The applied patent does not teach the

instantly claimed solid content of an aqueous dispersion. However, the final product of the instant application does not contain an aqueous dispersion instead it is a geotextile with polymeric binder. Therefore the applied art anticipates the final product of the instant application.

11. Claims 1-5 and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Markusch et al. (US 2002/0168531).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Markusch et al. teach a polyurethane treated geotextile for use as a ditch liner (Abstract). The applied geotextile anticipates the instantly claimed thickness and polyurethane basis weights [0059 and 0060]. The Table on page 6 teaches the instantly claimed the instantly claimed tensile strength and elongation. The applied patent does not teach the instantly claimed solid content of an aqueous dispersion. However, the final product of the instant application does not contain an aqueous dispersion instead it is a geotextile with polymeric binder. Therefore the applied art anticipates the final product of the instant application.

12. Claims 1-4 and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Markusch et al. (US 6,582,771).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Markusch et al. teach a polyurethane treated geotextile for use as a ditch liner (Abstract). The applied geotextile anticipates the instantly claimed thickness and polyurethane basis weights (col. 10, lines 33-40). The applied patent does not teach the instantly claimed solid content of an aqueous dispersion. However, the final product of the instant application does not contain an aqueous dispersion instead it is a geotextile with polymeric binder. Therefore the applied art anticipates the final product of the instant application.

Claim Rejections - 35 USC § 102/103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 5-7 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chavoret et al. (US 5,445,473).

The invention of Chaverot et al. has been previously disclosed, but does not explicitly teach the claimed elongation, tensile strength and water absorption, it is reasonable to presume that said properties are inherent to Chavoret et al. Support for said presumption is found in the use of like materials (i.e. aqueous polymeric impregnant for a geotextile). The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed elongation, tensile strength and water absorption would obviously have been present one the Chavoret et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

14. Claims 5-7 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dahmen et al. (US 4,774,131).

The invention of Dahmen et al. has been previously disclosed, but does not explicitly teach the claimed elongation, tensile strength and water absorption, it is reasonable to presume that said properties are inherent to Dahmen et al. Support for said presumption is found in the use of like materials (i.e. aqueous polyurethane coating for a geotextile). The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed elongation, tensile strength and water absorption would obviously have been present one the Dahmen et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

15. Claims 6-7 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Markusch et al. (US 2003/0206775).

The invention of Markusch et al. has been previously disclosed, but does not explicitly teach the claimed water absorption, it is reasonable to presume that said property is inherent to Markusch et al. Support for said presumption is found in the use of like materials (i.e. aqueous polyurethane coating for a geotextile). The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed water absorption would obviously have been present one the Markusch et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

16. Claims 5-7 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Markusch et al. (US 2003/0032718).

The invention of Markusch et al. has been previously disclosed, but does not explicitly teach the claimed elongation, tensile strength and water absorption, it is reasonable to presume that said properties are inherent to Markusch et al. Support for said presumption is found in the use of like materials (i.e. polyurethane coating for a geotextile). The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed elongation, tensile strength and water absorption would obviously have been present one the Markusch et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

17. Claims 6-7 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Markusch et al. (US 2002/0168907).

The invention of Markusch et al. has been previously disclosed, but does not explicitly teach the claimed water absorption, it is reasonable to presume that said property is inherent to Markusch et al. Support for said presumption is found in the use of like materials (i.e. polyurethane coating for a geotextile). The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed water absorption would obviously have been present one the Markusch et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

18. Claims 6-7 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Markusch et al. (US 2002/0168531).

The invention of Markusch et al. has been previously disclosed, but does not explicitly teach the claimed water absorption, it is reasonable to presume that said property is inherent to Markusch et al. Support for said presumption is found in the use of like materials (i.e. polyurethane coating for a geotextile). The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed water absorption would obviously have been present one the Markusch et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

19. Claims 5-7 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Markusch et al. (US 6,582,771).

The invention of Markusch et al. has been previously disclosed, but does not explicitly teach the claimed elongation, tensile strength and water absorption, it is reasonable to

presume that said properties are inherent to Markusch et al. Support for said presumption is found in the use of like materials (i.e. polyurethane coating for a geotextile). The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed elongation, tensile strength and water absorption would obviously have been present one the Markusch et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32, 1-4, 1-21, 2-14 and 19-32 and 1-9 of copending Application Nos. 10/761,072; 10/138,539; 09/809,023; 09/809,604; 09/808,812, respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because the articles are directed to polymer-coated geotextiles having the same physical properties and basis weights.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

21. Claims 1-11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 and 1-21 of U.S. Patent Nos. 6,632875 6,582,771, respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because both articles are directed to polymer-coated geotextiles having the same physical properties and basis weights.

Conclusion

22. The references provided by the International Search Report, but not relied upon herein have been found to not be explicitly applicable in the instantly claimed field of endeavor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Matzek whose telephone number is (571) 272-2423. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mdm MDM

TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700